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Michael C. Stuart Cohen, Pontani, Lieberman & Pavane Suite 1210 551 Fifth Avenue New York, NY 10176				HALPERN, MARK
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VILHO NISSINEN, TIMO NYBERG, PASI RAJALA,
LARS GRONROOS, PENTTI VIRTANEN, VELI KASMA,
HANNU NIEMELA

Appeal 2009-013109
Application 10/687,194
Technology Center 1700

Decided: November 24, 2009

Before KAREN M. HASTINGS, MICHAEL P. COLAIANNI, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claim 62. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Claim 62, the sole claim on appeal, reads as follows (emphasis added):

62. A use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, comprising:

treating the paper, board, or nonwoven product with the recycled calcium carbonate, *the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of deinking process of recycled fiber of the paper, board or non-woven product; reacting the lime with water to form calcium hydroxide; and reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate.*

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Sohara	5,759,258	Jun. 2, 1998
Virtanen	WO 98/16471	Apr. 23, 1998

The Examiner rejected claim 62 under 35 U.S.C. § 102(b) as anticipated by either Sohara or Virtanen.

ISSUES

Have Appellants demonstrated reversible error in the Examiner's determination that the process of claim 62 is anticipated by Sohara; specifically, have the Appellants demonstrated reversible error in the Examiner's determination the recycled calcium carbonate of Sohara is not patentably distinct from the recycled calcium carbonate in claim 62 because of how it was made?

Have Appellants demonstrated reversible error in the Examiner's determination that the process of claim 62 is anticipated by the use of the precipitated calcium carbonate of Virtanen?

We answer each of these questions in the negative.

PRINCIPLES OF LAW

Anticipation is a question of fact. *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986). As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983), it is only necessary for the claims to “‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.”

It has been well established that, when a product recited in product-by-process format reasonably appears to be the same as or obvious from a product of the prior art, the burden is on applicant to show that the prior art product is in fact different from the claimed product, even though the products may be made by different processes. Cf. *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). This principle applies even in the context of a process claim that recites a step of using a product defined by the method by which it is produced. Cf. *In re Hirao*, 535 F.2d 67, 69 (CCPA 1976).

FINDINGS OF FACT

Findings of fact throughout this opinion are supported by a preponderance of the evidence.

Sohara

The Examiner’s finding that Sohara describes treating paper using recycled precipitated calcium carbonate (recycled PCC) is not disputed (Ans. 4; Br. 8).

Sohara describes that their recycled PCC has virtually the same optical and physical properties as pure or virgin PCC particles (col. 2, ll. 15-21; col. 5, ll. 19-40; col. 7, ll. 36-40).

Appellants have not contended, nor provided any evidence, that the final recycled calcium carbonate product encompassed by, and used in the process of, Appellants' claim 62 does not read on the final recycled calcium carbonate product used in the process of Sohara.

Virtanen

Appellants do not dispute the Examiner's findings that Virtanen describes using PCC to treat paper, board, or nonwoven product (Ans. 4; Br. 10).

Appellants have not contended, nor provided any evidence, that the final calcium carbonate product encompassed by, and used in the process of, Appellants' claim 62 does not read on the final calcium carbonate product used in the process of Virtanen.

ANALYSIS

Anticipation is a question of fact. The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. Claim 62 is to the use of a calcium carbonate *product* "prepared by" the recited process, for treating paper, board, or nonwoven products. Appellants do not positively and specifically claim the process of making the recycled calcium carbonate but instead couch the claimed additive in product-by-process form¹. Accordingly, we construe claim 62 on appeal as a

¹ Compare *In re Hirao*, 535 F.2d 67. In *Hirao*, applicants specifically recited the process steps for making an additive product in method of use type claims. The solicitor argued that the claim was analogous to a product-by-process claim and that the court should not give weight to the process of preparation limitations. *Hirao*, 535 F.2d at 69. Contrast the *Hirao* case to

method of treating paper where a product-by-process (the calcium carbonate made by the recited process) is used.

There is no dispute that Sohara describes treating paper with a recycled calcium carbonate; rather, Appellants argue that the recycled calcium carbonate of Sohara was not made by a process which includes the step of “calcining into lime” as recited in claim 62 (Br. 7).

We understand the Examiner’s position to be that the recycled calcium carbonate of the claims reads on the recycled calcium carbonate made by Sohara; e.g., “regardless as to how the recycled calcium carbonate is formed” (Ans. 4, 5).

Appellants’ contention that the process of making the recycled calcium carbonate product of Sohara is different than the process as claimed in claim 62 is not persuasive of error in the Examiner’s rejection, since how the recycled calcium carbonate product was made does not appear to change the *final* product of the recycled calcium carbonate as recited in claim 62.

Thus, the burden was properly shifted to Appellants to prove that the claimed recycled calcium carbonate product used in claim 62 is patentably different than the prior art recycled calcium carbonate product used in Sohara. *See In re Thorpe*, 777 F.2d at 697.

Appellants have not even contended, much less shown, that making the recycled calcium carbonate in accordance with the claimed steps changes the final calcium carbonate product. Accordingly, Appellants have not presented evidence sufficient to refute the Examiner’s finding that there is no

claim 62 here on appeal, where the claimed additive is couched in product-by-process form.

patentable difference between the claimed recycled calcium carbonate product as used in claim 62 and that of the applied prior art.

Therefore, Appellants have not shown that the Examiner reversibly erred in rejecting claim 62 as anticipated by Sohara.

With respect to the rejection based on Virtanen, Appellants contend that Virtanen is silent with respect to recycling, that “[p]recipitated calcium carbonate is not another name for recycled calcium carbonate”, and that Virtanen is manufacturing PCC from “new starting materials” (Br. 10). Even assuming Appellants are correct, these contentions are not persuasive of reversible error.

The claimed “recycled calcium carbonate” is a product-by-process limitation (that is, a calcium carbonate product that has been made via a recycling process).²

Appellants have not even contended, much less directed us to any evidence, that the recycled calcium carbonate obtained by the recited method is any different than the PCC prepared in Virtanen.

Thus, for reasons similar to the reasons for affirming the first ground of rejection based on Sohara, we also affirm the Examiner’s rejection of claim 62 under 35 U.S.C. § 102(b) based on Virtanen.

² In Appellants’ process of making “recycled calcium carbonate”, previously made calcium carbonate is not directly “recycled”, since the calcium carbonate residue of a deinking process is first converted back into calcium hydroxide, and then calcium carbonate is re-formed via reaction with carbon dioxide.

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DECISION

The Examiner's decision to reject claim 62 under 35 U.S.C. § 102(b) as anticipated by Sohara or Virtanen is affirmed.

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a).

AFFIRMED

tc

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